

REMARKS

Applicant has studied the Office Action dated March 8, 2006. Claims 1, 2, 4-7 and 11-19 are pending. Claims 1, 11, 17 and 19 are independent claims. Claims 8-10 have been canceled without prejudice. New claim 19 has been added. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

§ 101 Rejection

The Examiner rejected claims 8-10 under 35 U.S.C. § 101 as directed to non-statutory subject matter. With this paper, claims 8-10 have been canceled without prejudice. It is respectfully submitted that the rejection is, therefore, moot and it is respectfully requested that the rejection be withdrawn.

§ 103 Rejections

Claims 1, 4 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Roeck et al. ("Roeck" U.S. Pat. No. 6,574,796) in view of DiNatale et al. ("DiNatale" WIPO Pub. No. WO 02/48897 A1) in view of Fawcett (U.S. Pat. No. 5,845,077). This rejection is respectfully traversed.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court recently stated in In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.' If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned." (citations omitted.)

It is respectfully noted that the Examiner, at page 4 of the Office action, indicates that "Roeck in view of DiNatale ... fails to teach of downloading the file only when the file is a more recent version" and asserts that Fawcett teaches "conducting an inventory of the current software before proceeding to downloading the most recent version" at col. 6, ll. 12-32. It is further respectfully noted that the Examiner has not specifically identified how "conducting an inventory of the current software before proceeding to downloading the most recent version" teaches the claim 1 recitation of storing of the detected configuration only when the detected configuration file is a more recent version than a configuration file previously stored in the non-volatile memory and it is respectfully submitted that asserted combination of references is not only improper, but even if considered, the teachings of Fawcett fail to cure the Examiner's indicated deficiency of Roeck and DiNatale.

It is respectfully noted that the present invention and the claims under consideration as well as the Roeck and DiNatale inventions are directed to the initialization of a cable modem. It is further respectfully noted that the present invention is specifically directed to "shortening the time required" for initializing a cable modem. See specification at pg. 1, ll. 7-9, and pg. 5, ll. 15-19. It is respectfully submitted that neither the specification and claims of the present invention nor Roeck and DiNatale disclose any user involvement in the cable modem initialization process. It is further respectfully submitted that requiring a user to participate in the cable initialization process would be contrary to the stated intent of the present invention of "shortening the time required" for initializing a cable modem.

On the other hand, it is respectfully noted that Fawcett is directed to a process for updating software installed on a computer that is performed after "an update service at a remote location" is accessed with, for example, a "modem" and the process further requires "a user" to both initiate the update process and to confirm any software updates that are performed. Col. 2, ll. 24-45, col. 5, ll. 29-47, col. 5, line 61, to col. 6, line 32, col. 6, ll. 50-55, col. 8, ll. 26-30. It is further respectfully noted that Fawcett specifically discloses that "No software is downloaded without the user's permission" at col. 8, ll. 29-30.

It is well-settled that a reference must provide some motivation or reason for one skilled in the art (working without the benefit of the applicants' specification) to make the necessary changes in the disclosed device. The mere fact that a reference may be modified in the direction of the claimed invention does not make the modification obvious unless the reference expressly or impliedly teaches or suggests the desirability of the modification. In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984); Ex parte Clapp, 227 USPQ 972, 973 (Bd. App. 1985); Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. App. 1984).

The Examiner bears the burden of establishing the existence of either 1) some objective teaching in the prior art or 2) knowledge generally available to one of ordinary skill in the art which would lead that individual to change the primary reference. In re Jones, 21 USPQ2d 1941, 1943-44 (Fed. Cir. 1992). Section 103 does not allow the Examiner to engage in a picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. In re Wesslau, 147 USPQ 391 (CCPA 1975).

As the CAFC has said, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. ACS Hospital Systems v. Montefiore Hospital, 221 USPQ 929, 933 (Fed. Cir. 1984). Indeed, it is not proper under 35 U.S.C. 103 to modify a prior art patent in a manner which would destroy that on which the invention of the prior art patent was based. Ex parte Hartman, 186 USPQ 366, 367 (PTO Bd. App. 1974).

It is respectfully submitted that one of ordinary skill in the art would **not** be motivated to modify the combination of the Roeck and DiNatale inventions, which disclose no user involvement in the modem initialization process, by the teachings of Fawcett, which requires a user's involvement and specifically requires "the user's permission" before any software is downloaded in order to attain the stated goal of the present invention of "shortening the time required" for initializing a cable modem. It is further respectfully submitted that to modify the combination of the Roeck and DiNatale

inventions according to the teachings of Fawcett would “destroy” that on which the Roeck and DiNatale inventions are based by requiring user involvement in the modem initialization process.

In view of the preceding arguments, it is respectfully asserted that the combination of the Roeck, DiNatale and Fawcett references is improper and it is respectfully requested that the rejection be withdrawn.

Notwithstanding that the combination of the Roeck, DiNatale and Fawcett references is improper, it is respectfully submitted that, even if the combination of the Roeck and DiNatale inventions was modified by the teachings of Fawcett, the resulting invention would not store of the detected configuration only when the detected configuration file is a more recent version than a configuration file previously stored in the non-volatile memory, as recited in claim 1. Applicant respectfully disagrees with the Examiner’s interpretation of the Fawcett reference.

It is respectfully noted that the result of the “inventory of the current software” to which the Examiner refers in Fawcett is a “summary report” that, depending upon which of “several update service options” are chosen by the user, may contain only a list of “new computer software (i.e. brand new products, not new or enhanced versions of existing products.” Col. 7, line 53, to col. 8, line 14. It is further respectfully noted that Fawcett discloses that the software that is ultimately downloaded is based on the user choice of “which available computer software shown in the output report, if any, will be downloaded” and, as previously noted, “[n]o software is downloaded without the user’s permission.” Col. 8, ll. 26-30. Therefore, it is respectfully submitted that the user in Fawcett may very well choose to download software other than a configuration file and, if a configuration file is chosen by the user for download, it may very well **not** be a more recent version than a configuration file previously stored in the non-volatile memory, as recited in claim 1.

It is respectfully asserted that claim 1 is allowable over the cited combination of references. It is further respectfully asserted that claims 4 and 7, which depend from claim 1, also are allowable over the cited combination of references.

Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Roeck in view of DiNatale in view of Fawcett as applied to claim 1, and further in view of Welles, II et al. ("Welles" U.S. Pat. No. 6,532,495). This rejection is respectfully traversed.

It is respectfully submitted that Welles fails to cure the deficiencies of Roeck, DiNatale and Fawcett with respect to independent claim 1 that were submitted previously. Therefore, it is respectfully asserted that claim 1 is allowable over the cited combination of references, as is claim 2 based on its dependence from claim 1.

Claims 8 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNatale in view of Rainard (U.S. Pat. No. 5,473,610). This rejection is respectfully traversed.

It is respectfully noted that claims 8 and 10 have been canceled without prejudice with this paper. It is respectfully submitted that the rejection is, therefore, moot and it is respectfully requested that the rejection be withdrawn.

Claims 11, 13, 14 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNatale in view of Fawcett. This rejection is respectfully traversed.

It is respectfully noted that independent claim 11 recites limitations similar to those of independent claim 1. It is respectfully submitted that the previous remarks with regard to Fawcett failing to cure the deficiencies of DiNatale with respect to independent claim 1 apply to independent claim 11. Therefore, it is respectfully asserted that claim 11 is allowable over the cited combination of references, as are claims 13, 14 and 16 based on their dependence from claim 11.

Claim 15 was rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNatale in view of Fawcett as applied to claim 11 and further in view of Rainard. This rejection is respectfully traversed.

It is respectfully submitted that Rainard fails to cure the deficiencies of DiNatale and Fawcett with respect to independent claim 11 that were submitted previously. Therefore, it is respectfully asserted that claim 11 is allowable over the cited combination of references, as is claim 15 based on its dependence from claim 11.

Claims 5 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Roeck in view of DiNatale in further view of Fawcett as applied to claim 1 and further in view of Gatherer et al. ("Gatherer" U.S. Pat. No. 6,549,584) in view of Rainard. This rejection is respectfully traversed.

It is respectfully submitted, that Gatherer and Rainard fail to cure the deficiencies of Roeck, DiNatale and Fawcett previously submitted with regard to claim 1. It is, therefore, respectfully asserted that claim 1 is allowable over the cited combination of references, as are claims 5 and 6 based on their dependence from claim 1.

Claim 9 was rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNatale in view of Rainard as applied to claim 8 and further in view of Beser (U.S. Pat. No. 6,775,276). This rejection is respectfully traversed.

It is respectfully noted that claim 9 has been canceled without prejudice with this paper. It is respectfully submitted that the rejection is, therefore, moot and it is respectfully requested that the rejection be withdrawn.

Claim 12 was rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNatale in view of Fawcett as applied to claim 11 and further in view of Gatherer. This rejection is respectfully traversed.

It is respectfully submitted that Gatherer fails to cure the deficiencies of DiNatale and Fawcett previously submitted with respect to independent claim 11. It is, therefore, respectfully asserted that claim 11 is allowable over the cited references, as is claim 12 based on its dependence from claim 11.

Claims 17 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DiNatale in view of Gatherer in view of Rainard in view of Fawcett. This rejection is respectfully traversed.

It is respectfully noted that independent claim 17 recites limitations similar to those of independent claims 1 and 11. It is respectfully submitted that the previous remarks with regard to Gatherer, Rainard and Fawcett failing to cure the deficiencies of DiNatale with respect to independent claims 1 and 11 apply to independent claim 17. Therefore, it is respectfully asserted that claim 17 is allowable over the cited combination of references, as is claim 18 based on its dependence from claim 17.

New Claims

With this paper, new claim 19 has been added. It is respectfully asserted that claim 19, which recites limitations similar to those of independent claims 1, 11 and 17, is allowable for the same reasons given herein with regard to claims 1, 11 and 17.

CONCLUSION

In light of the above remarks, Applicant submits that claims 1, 2, 4-7 and 11-18 of the present application are in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

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